

PATENT

Atty Docket No.: 100110550-1

App. Ser. No.: 10/032,245

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks. Claims 1-36 are pending in the present application of which claims 1, 11, 19, and 29 are independent.

Claims 11 and 19 were objected to because of informalities.

Claims 11-20 and 22-36 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Blight et al. (6,785,542).

Claims 1 and 5-10 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Blight et al. (6,785,542) in view of Manni et al. (7,194,689).

Claims 2-4 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Blight et al. (6,785,542) in view of Manni et al. (7,194,689) further in view of Gaucher (6,175,860).

Claim 21 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Blight et al. (6,785,542) in view of Official Notice.

The above objection and rejections are respectively traversed for at least the following reasons.

Claim Objection

Claims 11 and 19 were objected to because of minor informalities. These claims have been amended as suggested by the Examiner in the Office Action. Accordingly, withdrawal of the objection to claims 11 and 19 is respectfully requested.

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Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 11-20 and 22-36 were rejected under 35 U.S.C. §102(c) as allegedly being anticipated by Blight et al. (6,785,542).

Independent claims 11, 19, and 29

Blight et al. describes a mobile device (FIG. 7) that provides a user with a list of available information and resources in a network, which is maintained in a resource table 270 and gateway table 280 (col. 10, ll. 49+). The available resources are presented in an HTML page (col. 14, ll. 56-65). Thus, the information maintained by the mobile device and presented to the user is not a unique identification of the mobile device. Rather, such

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information provides an identification of available resources existing in the network that are available to the mobile device.

In contrast, claims 11, 19, and 29 have been amended to state, "pertinent network connectivity information pertaining to and *including a unique identification of said first electronic device.*" (Emphasis added). Support for the aforementioned claim amendment is found in the specification, in at least page 16, last paragraph and page 14, first paragraph.

To anticipate claims 11, 19 and 29, Barabi must teach each and every element of each claim, and "the identical invention must be shown in as complete detail as contained in the ... claim." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, because Blight et al. fails to teach each and every element arranged as stated in claims 11, 19 and 29, it fails to anticipate these claims and their dependent claims. Accordingly, withdrawal of the rejection of claims 11-36 and their allowance are respectively requested.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1 and 5-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blight et al. (6,785,542) in view of Manni et al. (7,194,689). Claims 2-4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blight et al. (6,785,542) in view of Manni et al. (7,194,689) further in view of Gaucher (6,175,860). Claim 21 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Blight et al. (6,785,542) in view of Official Notice.

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The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP §2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the aforementioned *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or

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other market forces if the variations would have been predictable to one of ordinary skill in the art;

- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

It is respectfully noted that application of any of these rationales is to occur only after a *Graham* factual inquiry is properly performed.

Independent claim 1

Similar to independent claims 11, 19, and 29, claim 1 has been amended to state, "wherein said network connectivity information includes *a unique identification of said associated electronic device.*" (Emphasis added). Again, support for the aforementioned claim amendment is found in the specification, in at least page 16, last paragraph and page 14, first paragraph.

Accordingly, it is respectfully submitted that, for at least the reasons set forth earlier, amended independent claims 1, 11, 19, and 29 are not anticipated by Blight et al. Moreover, a proper *Graham* inquiry has not been performed as the Examiner has apparently not realized the distinct differences between Blight et al and the present invention. At least one of these distinct differences is now further clarified to the Examiner by the amendment to claim 1 (as well as the amendments to claims 11 and 19).

In addition, the Office Action does not rely upon Manni et al., Gaucher, and the Official Notice to make up for the deficiencies in Blight et al. Indeed, Manni et al., Gaucher, and the Official Notice, separately or in combination, do not provide any network connectivity information that includes a unique identification of an associated electronic device as claimed.

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Moreover, with respect to the requirement of a *Graham* factual inquiry to determine the differences between the prior art and the claims at issue, it is clear that prior art references fail to provide salient claim elements that clearly distinguish the present claims over the prior art references. Application of any of the rationales A-G is therefore premature and unfounded as the references separately or in combination fail to anticipate the claim elements as set forth in independent claims 1, 11, 19 and 29

Accordingly, withdrawal of this rejection and allowance of claims 1-36 are respectfully requested.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please

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grant any required extensions of time and charge any fees due in connection with this request
to deposit account no. 08-2025.

Respectfully submitted,

Dated: June 19, 2008

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